

Submission  
Application No. 09/784,707  
Attorney Docket No. 030229

### **REMARKS**

Claims 1-4, 7, 8, 10-32, 39, 40 and 47-49 were rejected under 35 USC §112, as allegedly failing to comply with the written description requirement. The Examiner makes the rejection as it pertains to the amendments adding “at least” in regard to the cell distribution and stating the specific amylose contents of the starches in claims 47-49. This rejection is respectfully traversed.

In regard to the amendment of the cell distribution such that at least 80% of the cells have, in the absence of stretching, a size ranging from 20 to 400  $\mu\text{m}$ , the following clarifying remarks are submitted to overcome this portion of the rejection. In the prior response, applicants had indicated that support is provided by Example 10, but the remarks erroneously referred to a dimension from “40 to 400  $\mu\text{m}$ .” The cell dimension size between 35 and 188  $\mu\text{m}$  is fully supported by the original claim 1 stating a size ranging from 20 to 400  $\mu\text{m}$ . Therefore, the amendment does not constitute new matter.

In regard to support to the specific amylose contents recited in claims 47-49, the amylose content is inseparable from the specific starch and vice versa. As set forth in MPEP §2173.07(a), an application may later be amended to recite a function, theory or advantage without introducing new matter. That is, by disclosing a device (or compound) that inherently performs a function or has a property, a patent application necessarily discloses that function or property, even though it says nothing explicit concerning it. The amylose content is an inherent property of each of the specific starches disclosed in the specification. The “Starch Chemistry and Technology” article

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provides the extrinsic evidence which makes it clear that the missing descriptive matter is necessarily present in the described starches such that it would be recognized by a person of ordinary skill. Thus, although the Examiner asserts that there has been no incorporation by reference in the present specification, such incorporation by reference is not necessary.

Furthermore, there are several case decisions which authorize the addition to the specification of descriptive matter concerning the properties of a compound. For example, in In re Nathan, 140 USPQ 601, the court held that the later-added limitation to the claims of the compound's orientation was "an inherent characteristic" of the claimed subject matter, and reversed a new matter rejection. See also Kennecott Corp. v. Kyocera International Inc., 5 USPQ 2d 1194 (CAFC 1987).

Claims 1-4, 7, 8, 10-32, 39, 40 were rejected under 35 USC §103(a) as being unpatentable over Altieri. The Examiner boldly states that Altieri teaches that starches from different sources may be used, referring to column 4, lines 4-15 and 38-40. The Examiner's statement is not precisely what Altieri teaches.

As repeatedly emphasized in the prior responses, Altieri teaches that its invention is directed to high amylose starches, i.e., one containing at least 45% by weight of amylose. At column 4, lines 4-15, Altieri mentions starches from different sources, but does not teach that starches from such different sources can be used in its invention. More specifically, the disclosure at column 4, lines 4-15 clearly teaches that high amylose starch (one containing at least 45% by weight of amylose) is useful in its invention. Lines 13-16 mention starches from

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different sources as being characterized by different relative proportions of the amylose and amylopectin components. Nowhere does Altieri teach that potato, corn, tapioca and rice may be used in its invention, but in fact Altieri teaches away from use of such starches.

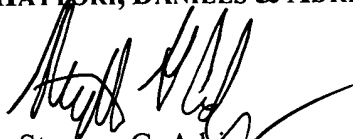
The working examples of Altieri serve as further evidence of the teaching away from use of starches which contain less than 45% by weight amylose. For example, Example 1 provides a comparison of samples using starch materials containing varying amounts of amylose content, including corn (25-28% amylose), waxy maize corn (0-1% amylose), potato (23% amylose), HylonV (50% amylose) and HylonVII (70% amylose). The results show that the high amylose starches, i.e., HylonV and VII had an essentially uniform, closed cell structure with tiny bubble formation whereas the starches containing significantly lower than 45% amylose content, i.e., corn starch, waxy maize starch and potato starch, all gave an expanded product which had a poor, relatively open cell structure, and were brittle and crushed.

Applicants are currently preparing a declaration as further evidence of the patentability of the claimed invention. The declaration will be submitted as soon as it has been completed.

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If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,  
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A handwritten signature in black ink, appearing to read 'Stephen G. Adrian', is written over the printed name.

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Attachments: RCE Transmittal  
Petition for Extension of Time